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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/670,152	09/24/2003	Federico J. Benetti	GUID-008CON2	2852
36154 7590 07/26/2007 LAW OFFICE OF ALAN W. CANNON 942 MESA OAK COURT SUNNYVALE, CA 94086			EXAMINER PHILOGENE, PEDRO	
			ART UNIT 3733	PAPER NUMBER
			MAIL DATE 07/26/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/670,152

Applicant(s)

BENETTI ET AL.

Examiner

Pedro Philogene

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 November 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 13-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/27/06 has been entered.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 13,24-28,31-34,36-39 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1,8-20 of U.S. Patent No. 6,199,556 in view of Deckman et al (5,984,867).

With respect to the above claims, it is noted that the patent claims disclose all the limitation, except for the main body or retractor remains resting against the frontal body

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of the patient; as claimed by applicant in claims 13,24-28,31-34,36,31. However, in a similar art, Deckman et al evidences the use of a surgical retractor having a main body or retractor that remain resting against the frontal body of the patient so as to help elevate one side of the retractor body thereby lifting at least a portion of the ribs of the patient.

Therefore, given the teaching of Deckman et al, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the device '556 as taught by Deckman et al., to help elevate one side of the retractor body thereby lifting at least a portion of the ribs of the patient.

Claims 13,24-28,31-34,36-39 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-13 of U.S. Patent No. 6,736,774 in view of Deckman et al. (5,984,867).

With respect to the above claims, it is noted that the patent claims disclose all the limitation, except for the main body or retractor remains resting against the frontal body of the patient; as claimed by applicant in claims 13,24-28,31-34,36,31. However, in a similar art, Deckman et al evidences the use of a surgical retractor having a main body or retractor that remains resting against the frontal body of the patient so as to help elevate one side of the retractor body thereby lifting at least a portion of the ribs of the patient.

Therefore, given the teaching of Deckman et al., it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the

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device '556 as taught by Deckman et al., to help elevate one side of the retractor body thereby lifting at least a portion of the ribs of the patient.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 13-28,31-39 are rejected under 35 U.S.C. 102(e) as being anticipated by Deckman et al. (5,984,867).

With respect to claims 13, 31,37,38, Deckman et al disclose a surgical apparatus for accessing a beating heart, the apparatus comprising a main body (102) configured to rest against the frontal body of a patient; and a lifting arm (110) movably mounted to the main body and adapted to engage and lift at least a portion of the ribs of the patient, relative to remainder of the patient's body below the rib cage, while the body or retractor remains resting against the frontal body of the patient, when the patient is positioned horizontally; as best seen in FIG.12; a retractor arm mounted to the main body and adapted to engage and spread a portion of the ribs with respect to the remainder of the ribs, in a direction different from a direction of the lifting, wherein the retractor arm comprises a hinge to enhance positioning of a distal end of the retractor arm to engage

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the ribs; as set forth in column 5, lines 33-67, column 6, lines 1-35; wherein the retractor arm is rotatably mounted to the body; as best seen in FIG.5.

With respect to claims 14-28, 32-36, 39, Deckman et al disclose all the limitations, as set forth in column 3, lines 12-56, column 4, lines 1-67, column 5, lines 1-67, column 6, lines 1-24; and as best seen in FIGS.1-12.

With regard to the recitation that an element is "adapted to" or "configured to" it is noted that it has been held that the recitation that an element is "adapted to" or "configured to" perform a function is not a positive limitation but requires the ability to so perform. It does not constitute a limitation in any patentable sense. In addition, the manner in which a device is intended to be employed, does not differentiate the claimed apparatus from the prior art apparatus satisfying the claimed structural limitations. Ex parte Masham, 2 USPQ2d 1647 (1887).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 29,30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Deckman et al. (5,984,867) in view of Asrican (3,680,546).

With respect to the above claims, it is noted that Deckman did not teach of fiber optic light; as claimed by applicant. However, in a similar art, Asrican evidences the use of fiber optic light to serve to direct the direction of light in the chest cavity.

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Therefore, given the teaching of Asrican, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the device of Deckman et al., as taught by Asrican, to serve to direct the direction of light in the chest cavity.

Response to Amendment

Applicant's arguments with respect to claims 13-39 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

6,416,468

7-2002

Deckman et al.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pedro Philogene whose telephone number is (571) 272-4716. The examiner can normally be reached on Monday to Friday 6:30 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on (571) 272 - 4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Pedro Philogene
July 10, 2007


PEDRO PHILOGENE
PRIMARY EXAMINER